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08/330,573	10/28/94	AIDA	M.

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EXAMINER	
OH, J	
ART UNIT	PAPER NUMBER
2411	15

DATE MAILED: 12/06/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.
08/330,573

Applicant(s)
Aida

Examiner
Junghoon Kenneth Oh

Group Art Unit
2411



☒ Responsive to communication(s) filed on Oct 4, 1996

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 28-35 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 28-35 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Part III DETAILED ACTION

Claim Objections

1. Claim 28-35 are objected to because of the following informalities: The claims are replete with grammatical errors and other informalities. Appropriate correction is required.

Followings are the errors that the Examiner has found in claim 28:

- 1) Line 3; "word" should be changed to "words".
- 2) Line 4; "a string" should be changed to "strings".
- 3) Line 25 and 28; "a line" and "is" should be changed to "lines" and "are", respectively.
- 4) Line 18-10; "said word which was selected by said word for selecting said word" should be changed to "said selected desired word".

Examiner respectfully requests Applicant to make corrections for the rest of claims.

Examiner wishes to make a note that foregoing suggested corrections are only illustrative rather than exhaustive. Therefore, Examiner recommends that corrections should be made for rest of the claims accordingly.

Claim Rejections - 35 USC § 112

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2. Claim 28-35 rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 28-35, which simultaneously claim both statutory classes, namely, apparatus and method, are indefinite and ambiguous since the claims include method in the preamble and apparatus language in the form of means plus function language. In Ex parte Lyell 17 USPQ2d 1548 (Bd. PQ & I 1990). In other words, they are hybrid claims, which are not allowed under 37 CFR 1.75. The Examiner recommends that the Applicant makes either of changes:

1) substitute the word "method" in the preamble for "apparatus", i.e. line 1 and 22 in claim 28, or

2) substitute step language for means plus function language.

Similarly, Applicant should make appropriate corrections for the rest of the claims.

4. Lines 6-10 in claim 28 are not clear as to what forms an abbreviation or a shorthand just from reading the claim. Put it another way, language in the claim recites that plurality of strings of characters form an abbreviation or a shorthand. However, Examiner suspects that was not what the Applicant meant.

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One possible way that line 6-10 can be rewritten is "dictionary means for storing a plurality of strings of characters; each of which forms an abbreviation or a shorthand and a word corresponds to each said strings of characters," assuming that it was an apparatus claim.

5. Lines 10-16 recite "means for determining said word in said dictionary means which equals said word input, being actuated by the corresponding key; means for selecting a desired word among words which were selected by said means for determining said word." Examiner asserts that means for selecting is not consistent with what means for determining tries to accomplish because from reading the claim, Examiner's understanding is that there can be only one word that equals said word input from means of determining. However, means for selecting limitation in the claim seems to be written that there are more than one word from means for determining.

6. Lines 28-30 in claim 28 recite "which is derived from one of relevant words and relevant words." Examiner asserts that it is not clear whether a line of text can be derived from more than one relevant word or just one relevant word.

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7. Lines 31-40 in claim 28, which recites means for determining, as a whole is not clear or too vague. For instance, Applicant's use of a word "unique" in line 33 seems redundant since it already has been recited in line 31. Further, it is not clear to what "to be done" in line 37 refers, and Applicant should avoid using relative terms, such as etc., in line 39.

8. Lines 41-55 in claim 28, which recites means for selecting a desired word among said relevant words, as a whole, are too vague and indefinite. For instance, line 45 recites "which is unique and terminates with the same one as the last input" Yet, it is not clear why the desired word has to terminate with the same one as the last input after it already has been recited as unique. Similarly, subsequent limitations should be corrected.

9. As to claims 28,29 and 32, the Examiner recommends that "could be" language should be avoided in claims because it makes the claims indefinite and vague.

Response to Remarks

10. The Applicant's amended claims and response to the examiner's questions have been considered very carefully. However, the examiner still finds them to be very difficult to

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comprehend because of discrepancies between the Applicant's response and amended claims. As to the claims 28-33 and 35, limitation recited therein attempts to claim determining a unique part of a word and selecting a desired word. However, this does not correctly correspond or at least, is not consistent with Applicant's response. More specifically, the Applicant has provided an explanation as follows: "In the invention system the word is only displayed when it has been uniquely identified and the system makes an audible noise to alert operator despite the kinds of input of:

- 1) some leading characters(strokes) to be unique.(character by character or stroke by stroke).
- 2) first character and some other characters to be unique.
- 3) first and end part to be unique.
- 4) first and last character and some other characters between first and last one to be unique.
- 5) stem of word and the last character to be unique.
- 6) stem of word and the some other character to be unique."

However, the Examiner respectfully asserts that the Applicant's claims are not clear or too vague to extract six foregoing inputs, except 1) from reading the claims. The Examiner recommends that corrections should be made accordingly.

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11. According to the Applicant's response, Applicant has stated that any standard dictionary can be used in the invention. However, claim 18 recites that "dictionary means for storing a plurality of a string of characters to form an abbreviation or a shorthand and its corresponding word" in line 6-10 and dictionary means for storing a plurality of the line of text which is derived from one of relevant word and relevant words". Examiner respectfully asserts that dictionary recited in the claim includes more than what a standard dictionary includes.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Conclusion

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13. Thank you for sending in the duplicates of amendments and remarks. However, examiner wishes to remind Applicant that it is not necessary to send in the duplicates once the documents has been submitted by facsimile.

14. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Junghoon Kenneth Oh whose telephone number is (703) 305-4645, or Gail Hayes whose telephone number is (703) 305-9711.

Any inquiry of a general nature or relating to the status of this applications should be directed to the Group receptionist whose telephone number is (703) 305-3800.

Information associated with this application may be submitted by facsimile on (703) 305-9731.

JKO

JKO

November 8, 1996

Gail Hayes
GAIL O. HAYES
SUPERVISORY PATENT EXAMINER
GROUP 2400